

### **REMARKS**

The Final Office Action dated March 31, 2006 has been reviewed carefully and the application amended in a sincere effort to place the remaining amended claims in condition for allowance. Furthermore, reconsideration of the rejection of the remaining claims, which have been amended directly or indirectly, and allowance of the same, are respectfully requested on the basis of the following remarks.

Upon entry of this response, claims 1-21, 23-26, and 29-44 will be pending in this application. Claim 22 and 27-28 have been canceled.

Claims 1, 11, and 20 have been amended to recite that the determination step occurs on the mobile device based on the preferred roaming list. Claims 1, 11, and 20 have also been amended to recite that the determining step can override the network preferences stored in the preferred roaming list.

Claims 29 and 37 have been amended to recite that the system preference criteria are provided in a preferred roaming list on the mobile device. Claims 29 and 37 have also been amended to recite that the determining step can override the network preferences that are stored in the preferred roaming list.

Support for these amendments can be found on page 2, lines 5-7, page 7, line 16, to page 11, line 26, as well as page 8. Since the amendments are supported in the Application as originally filed, no issue of new matter is presented.

### **The Invention**

In general, the present invention relates to a system and method wherein a mobile data device is provided with a preferred roaming list that includes information indicating whether each network in the list (e.g. a 3G network) supports 3G data capabilities (as opposed to, for example, 3G voice capabilities). This is advantageous because not all 3G networks are capable of supporting data services and by including

information regarding the 3G data capabilities of the network in the preferred roaming list the battery life of the mobile data device is prolonged or preserved since the mobile data device will not attempt to access a 3G network lacking 3G data capabilities when 3G data capabilities are needed.

**Rejection of Claims 1-10, 11-19, 20, and 21-26**

The Examiner has rejected these claims under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Guilford.

In general, Bridges (WO 99/45723) describes an intelligent roaming system with over the air programming. Specifically, Bridges describes a method and apparatus for selecting one of a plurality of wireless carriers for use by a roaming mobile station. A list of preferred carriers is generated by a database and downloaded to the mobile station handset. See page 4, line 24, to page 8, line 24. The handset can then find a system identifier for an available network and scan through the list to see if that system might be a preferred carrier and, if not, obtain from the list an alternative carrier. Accordingly, the system described in Bridges is a very network centered solution in which the network generates the preferred roaming list and provides preferred networks to connect to. This may not always provide a mobile device with the desired result and the mobile device could require a new network based on the network's capabilities or service offerings. This requirement could arise at any time without the desire to waste additional battery life and bandwidth by requesting an updated priority list from the network.

Claims 1, 11, and 20 have been amended to recite that the decision making is done at the mobile device based on the preferred roaming list. This is contrary to Bridges which describes that the step for determining which preferred network to use is done by a database at the network and subsequently downloaded to the mobile

device. Moreover, claims 1, 11, and 20 have been amended to recite that the mobile device can override the network preferences in a preferred roaming list. Bridges, however, does not describe a mobile device that has this capability.

The Examiner also contends that Guilford (US 2002/0087674) describes intelligent network selection based on the quality of service and applications over different wireless networks. In general, Guilford teaches a system in which a device includes a table with various networks. These networks are ranked into preferred second generation (2G) networks, preferred third generation (3G) networks, and preferred networks based on the quality of service. In order to acquire a network, the device connects to the first network that it finds. See paragraphs [0058] – [0060]. If services are requested that are not supported by the network, the network will then tell the device to move to a different type of network. For example, paragraph [0059] states the following:

As the wireless device 12 is registering with the network, the network node 56 receives information regarding the streaming video service requested by the wireless device 12. **The 2G network realizes that its capabilities are limited for the service requested.** An algorithm operating on the wireless device 12 references the table and instructs the wireless device 12 to register with the 3G wireless network according to the data in the table. In this manner, the wireless device 12 may register with the appropriate network that can handle its high-speed data request. (emphasis added)

While paragraph [0059] is silent as to the reason why the wireless device references the table and registers with the 3G network, the paragraph indicates that the 2G network realizes that its capabilities are limited. Accordingly, the network must instruct the wireless device that its services are not adequate for the wireless device's request. That is, the intelligence for this network is on the network and not on the mobile device. Finally, as stated above, claims 1, 11, and 20 have been

amended to recite that the mobile device can override the network preferences in a preferred roaming list. This capability is not taught by Guilford either alone or in combination with Bridges.

Because Bridges and Guilford fail to disclose all of the elements of amended claims 1, 11, and 20, the Applicants respectfully submit that the rejection of claims 1, 11, and 20, as well as the claims that depend directly or indirectly from them, on the ground of obviousness has been successfully overcome. Accordingly, withdrawal of the rejection is respectfully requested.

**Rejection of Claims 27 and 28**

Claims 27 and 28 have been canceled. Accordingly, the rejection of these claims is now moot.

**Rejection of Claims 29-33, 35, 37-41, and 43-44**

The Examiner has rejected claims 29-33, 35, 37-41, and 43-44 under 35 U.S.C. 102(e) as being anticipated by Islam (U.S. 2005/0090277).

In general, Islam describes a system and method in which a mobile device keeps track of networks that it has connected to and stores whether or not these networks have data capabilities. Based on the history, the mobile device can then choose which network to connect to.

Claims 29 and 37 have been amended to recite that the preferred roaming list is provided to the mobile device. As will be appreciated, this provides the advantage of having all of the information required already stored on the mobile device rather than having to use a trial-and-error method, in combination with a history, in order to determine the characteristics of a network. Furthermore, claims 29 and 37 have been amended to recite that the choosing step can override the network preferences that are

stored in the preferred roaming list. This capability is not disclosed in the Islam reference.

Because Islam fails to disclose all of the elements of amended claims 29 and 37, the Applicants respectfully submit that the rejection of claims 29 and 37, as well as the claims that depend directly or indirectly from them, has been successfully overcome. Accordingly, withdrawals of the rejections are respectfully requested.

**Rejection of Claims 34 and 42**

Claims 34 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Islam in view of Almgren (WO 2004/066663). Claim 34 depends directly from claim 29 while claim 42 depends indirectly from claim 37. In general, Almgren describes a method of managing roaming mobile subscribers based on different control fields saved on a mobile device. See Abstract. As stated above, Islam does not disclose every element recited in amended claims 29 and 37.

Since the combination of Islam and Almgren does not teach every element recited in amended claims 34 and 42, Applicants submit that claims 34 and 42 are in condition for allowance and withdrawal of the rejection is respectfully requested.

**Rejection of Claim 36**

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Islam in view of Russell (US 2004/0249915). Claim 36 depends directly from claim 29. In general, Russell describes a system in which a wireless device uses Global Positioning Data to determine its location so that it may access an appropriate wireless network. See Abstract. As stated above, Islam does not disclose every element recited in amended claim 29.

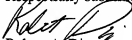
Because the combination of Russell and Islam does not describe every element recited in amended claim 29, Applicants submit that claim 36 is in condition for allowance and request that the rejection of this claim be withdrawn.

**CONCLUSION**

In light of the foregoing amendments and arguments, it is respectfully submitted that claims 1-21, 23-26, and 29-44, are in proper form for issuance of a Notice of Allowance and such action is respectfully requested at an early date.

In the event that any outstanding matters remain with this application, examiner is invited to telephone the undersigned at 412-566-1920 to discuss such matters.

Respectfully submitted,



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